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| 10/616,120 | 07/03/2003 | Jin Cheng Lin | 19339-094338 | 2206 |

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09/29/2004

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EXAMINER

ENGLE, PATRICIA LYNN

ART UNIT

PAPER NUMBER

3612

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,120

Applicant(s)

LIN ET AL.

Examiner

Patricia L Engle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-26 is/are allowed.
- 6) ☒ Claim(s) 1-16 and 21 is/are rejected.
- 7) ☒ Claim(s) 17-20 and 22 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/7/03; 12/15/03
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____

DETAILED ACTION

Priority

1. This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a Continuation in Part of Application No. ***, filed ***." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included.

The chain of priority is confusing. Application No. 10/774,185 claims that it is a C-I-P of the current Application (No. 10/616,120) which is a C-I-P of 10/250,837 which is a 371 of PCT/CA03/00040. However, the current Application (10/616,120) states in the declaration that it is a C-I-P of PCT/CA03/00040. Please clarify the chain of priority and add the priority statement to the current application.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 29, 204, 170.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because in Fig. 6, reference character "46" should be --48--. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement

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Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: In the paragraph beginning on page 7, lines 24 and the paragraph beginning on page 8, line 11, the reference characters do not match up with the elements recited (an example is inside release handle is stated in those paragraphs as being element 18, but in earlier in the specification and in the drawings it is element 22); also it is unclear what the difference between those two paragraphs is.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishikawa et al. (US 2001/0017476).

Regarding claim 1, Nishikawa et al. disclose a method for assembling a motor vehicle door having a structural door body (D), a plurality of hardware components (Fig. 1), a secondary trim component (P), and a trim panel (T), the method comprising the steps of: providing said trim panel (T) with a map pocket opening(44); providing said secondary trim (P) component with a map pocket wall (15); affixing the plurality of hardware components to the secondary trim component (P) to form a door module assembly; installing the door module assembly (P) to the structural door body (D); securing the trim panel (T) to the structural door body (D) overlaying the door module assembly (P), said trim panel (T) cooperating with the secondary trim component (P) to define a map pocket (44).

Regarding claim 2, Nishikawa et al. disclose the method as set forth in claim 1 including the step of forming access holes (D1) in the structural door body (D) prior to the step of installing the door module assembly (P) to the structural door body (D).

Regarding claim 3, Nishikawa et al. disclose the method as set forth in claim 2 wherein the installing step includes at least partially inserting the door module assembly (P) into the access holes (D1) of the structural door body.

Regarding claim 4, Nishikawa et al. disclose the method as set forth in claim 3 wherein the affixing step includes aligning each of the plurality of hardware components along the secondary trim component (P) for orientation relative to the structural door body (Fig. 1).

Regarding claim 5, Nishikawa et al. disclose the method as set forth in claim 4 including the step of removing the trim panel (T) from the structural door body (D) to expose a portion of the access holes (D1) for accessing one of the plurality of hardware components (H) secured to the structural door body (D).

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Regarding claim 6, Nishikawa et al. disclose a method for assembling a motor vehicle door (D) having a structural door body (D), a plurality of hardware components (Figs. 1 and 2), a map pocket component (15), and a trim panel (T), the method comprising the steps of: affixing the plurality of hardware components to the map pocket component (15) to form a door module assembly (P); installing the door module assembly (P) to the structural door body (D); and securing the trim panel (T) to the structural door body (D) overlaying the door module assembly (P).

Regarding claim 7, Nishikawa et al. disclose the method as set forth in claim 6 including the step of forming the access holes (D1) in the structural door body prior to the step of installing the door module assembly to the structural door body (D).

Regarding claim 8, Nishikawa et al. disclose the method as set forth in claim 7 wherein the installing step includes at least partially inserting the door module assembly (P) into the access holes (D1) of the structural door body.

Regarding claim 9, Nishikawa et al. disclose the method as set forth in claim 8 wherein the affixing step includes aligning each of the plurality of hardware components along the map pocket component (P) for orientation relative to the structural door body (Fig. 1).

Regarding claim 10, Nishikawa et al. disclose the method as set forth in claim 9 including the step of removing the trim panel (T) from the structural door body (D) to expose a portion of the access holes (D1) for accessing one of the plurality of hardware components (H) secured to the structural door body (D).

Regarding claim 11, Nishikawa et al. disclose a door module comprising a trim panel (T) having a map pocket opening (44); a secondary trim component (P) having a map pocket wall

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(15); a plurality of door hardware components (Fig. 1) affixed to the secondary trim component (P) said trim panel (T) cooperating with the secondary trim component (P) to define a map pocket (44) when the trim panel (T) overlays said secondary trim component (P).

Regarding claim 12, Nishikawa et al. disclose the door module according to claim 11, wherein the secondary trim component (P) is formed from molded plastic (second to the last line of paragraph 0043).

Regarding claim 13, Nishikawa et al. disclose the door module according to claim 12, wherein the secondary trim component (P) includes an integrated speaker housing (14).

Regarding claim 14, Nishikawa et al. disclose the door module according to claim 12, wherein the secondary trim component (P) includes an integrated energy absorbing structure (16).

Regarding claim 15, Nishikawa et al. disclose the door module according to claim 12, wherein the secondary trim component (P) includes a sealing bead (19) around the perimeter thereof for sealing the component against a door structure, whereby one side of the secondary trim component is waterproofed.

Regarding claim 16, Nishikawa et al. disclose the door module according to claim 15, wherein the secondary trim component (P) includes a mount (R) for mounting a window regulator motor (R3) on the waterproofed side of the secondary trim component (P).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al. in view of Seeberger et al. (US Patent 6,185,872, filed on July 17, 1998).

Nishikawa et al. disclose the door module according to claim 11.

Nishikawa et al. do not disclose that the trim panel includes an upper and lower trim panel.

Seeberger et al. disclose a trim panel that is an upper and lower section.

Seeberger et al. and Nishikawa et al. are analogous art because they are from the same field of endeavor, i.e., door modules with trim panels.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to make the trim panel include an upper section and a lower section since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.

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Therefore, it would have been obvious to combine Seeberger et al. with Nishikawa et al. to obtain the invention as specified in claim 21.

Double Patenting

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claims 1-11 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of copending Application No. 10/250,837). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Allowable Subject Matter

13. Claims 17-20 and 22 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claims 23-26 are allowed.

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Conclusion

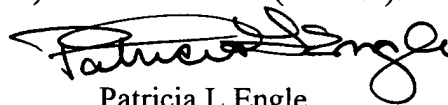
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art discloses other doors with inner panels and trim panels.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L Engle whose telephone number is (703) 306-5777.

The examiner can normally be reached on Monday - Friday from 8:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Glenn Dayoan can be reached on (703) 308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L Engle
Examiner
Art Unit 3612

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September 21, 2004